

REMARKS / DISCUSSION OF ISSUES

In response to the final Office action¹ mailed on 2 April 2009 ("Office action"), the applicants respectfully request reconsideration. All of the issues raised in the Office action have been carefully considered and are addressed herein.

Claims 1-16 and 18-22 are pending in the application.

I. Restriction requirement – claims 20-22

The Examiner restricts prosecution of this case to claims 1-16 and 18-19, asserting that claims 1-16 and 18-19 address a species that is illustrated in FIG. 8, and claims 20-22 address a species that is illustrated in FIG. 10. **This assertion is incorrect.**

FIG. 8 illustrates a block diagram of a lighting system that includes a comparator 14, and FIG. 10 illustrates an example embodiment of this comparator 14.

Claim 20 claims a system that includes a voltage source, a generator, and a comparator. FIG. 8 (*not* FIG. 10) illustrates a voltage source 10, a generator 16, and a comparator 14. FIG. 10 does not illustrate a voltage source and does not illustrate a generator, and thus cannot be said to correspond to the invention claimed in claim 20, as asserted in this Office action.

Because this restriction requirement is improper, the applicants respectfully request withdrawal of the restriction, and corresponding examination of claims 20-22. If the application is not found to be in condition for allowance, the applicants respectfully request a new Office action that addresses all of the pending claims, so that the applicants have a fair opportunity to address the Examiner's remarks with respect to each of the claims.

¹ The Office action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant(s) decline to automatically subscribe to any statement or characterization in the Office action.

II. Rejection of claims 1, 3, 6-7, and 12-14 under 35 U.S.C. 102(e)

The Examiner rejects claims 1, 3, 6-7, and 12-14 under 35 U.S.C. 102(e) over Sun et al. (USPA 2004/0183463, hereinafter Sun). The applicants respectfully traverse this rejection.

MPEP 2131 states:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)... "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Also, the Board of Patent Appeals and Interferences has consistently upheld the principle that the burden of establishing a prima facie case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements is found in the prior art:

"there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet [the] burden of establishing a prima facie case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out where *all* of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

Sun fails to teach operating a discharge lamp in a first mode of operation having a first operating frequency, which is activated when a burning voltage of the lamp is at least as high as a first limit value, and a second mode of operation with a second operating frequency that is higher than the first operating frequency, which is activated when the burning voltage of the lamp is not more than the first limit value, as specifically claimed in claim 1, upon which claims 2-12 and 16 depend. Claim 13, upon which claims 14-15 and 18-19 depend (and claim 20, upon which claims 21-22 depend) includes similar features.

Sun teaches a starting mode during which the operating frequency is continually swept between an upper f1 and lower frequency f2 ([0069]). Sun does not teach that this sweeping of the operating frequency is dependent upon the lamp voltage, other than to state that the lamp enters a normal operating mode when the lamp voltage indicates that the lamp has been ignited ([0071]). Neither f1 nor f2 is dependent upon whether a burning voltage is above or below a limit value, as claimed in claims 1 and 13.

The Office action asserts that Sun operates a first mode having the frequency f1, and a second mode having the frequency f2, and asserts that the first mode is entered when a burning voltage is above a limit value, and that the second mode is entered when the burning voltage is below the limit value at paragraphs [0028-0029]. This assertion is incorrect. Sun's paragraphs [0028-0029] do not address a burning voltage being above or below a limit value:

"[0028] Another aspect of the invention includes a method for driving a discharge lamp, comprising generating a starting voltage in a discharge lamp circuit for a first start time period, sweeping a frequency of the starting voltage during the first start time period, measuring the lamp voltage, ending the starting when the lamp voltage is less than a predetermined voltage, and turning off the discharge lamp circuit when the lamp voltage is one of more than and equal to the predetermined voltage for a second start time period.

[0029] This method further includes that the sweeping of the frequency is from at least a first frequency to a second frequency, the sweeping of the frequency is from at least a first frequency to a second frequency and back to the first frequency, or the sweeping of the frequency is from at least a first frequency to a second-frequency and then from at least the first frequency to the second frequency. The method can also include ensuring that a resonant frequency of an ignition network of the discharge lamp circuit to be between the first frequency and second frequency. The method may also include repeating, for a third start time period, generating the starting voltage in the discharge lamp circuit for the first start time period, measuring the lamp voltage, and turning off the discharge lamp circuit when the lamp voltage is one of more than and equal to the predetermined voltage for the second start time period."

As taught by Sun, both frequencies f1 and f2, and frequencies between, are applied during a starting period. This starting period ends, ceasing both frequencies, when the lamp voltage is less than a predetermined voltage. As long as the lamp voltage remains above the predetermined voltage, during the starting period, the frequency will vary/sweep between these two frequencies, f1 and f2; when the voltage drops below the predetermined voltage, indicating that the lamp has ignited, the starting period ends, ceasing the sweeping between the frequencies f1 and f2.

Because Sun does not teach a first frequency that is applied when the burning voltage is above a predetermined voltage and a second, higher, frequency that is applied when the burning frequency is below the predetermined voltage, and specifically teaches that **both** frequencies are applied when a voltage is above a predetermined voltage, and that **both** of these frequencies are terminated when the voltage is below the predetermined voltage, the applicants respectfully maintain that the rejection of claims 1, 3, 6-7, and 12-14 under 35 U.S.C. 102(e) over Sun is unfounded, and should be withdrawn.

III. Rejection of claims 2, 4-5, and 15-16 under 35 U.S.C. 103(a)

The Examiner rejects claims 15-16 under 35 U.S.C. 103(a) over Sun, and claims 2 and 4-5 under 35 U.S.C. 103(a) over Sun and Kumagai et al. (USPA 2006/0049777, hereinafter Kumagai). The applicants respectfully traverse these rejections.

Each of these rejected claims is dependent upon claim 1 or 13, and in this rejection, the Examiner relies on Sun for teaching the elements of claims 1 and 13. As noted above, Sun fails to teach the elements of claims 1 and 13. Accordingly, the applicants respectfully maintain that the rejections of claims 2, 4-5, and 15-16 under 35 U.S.C. 103(a) that rely on Sun for teaching the elements of claims 1 and 13 is unfounded, and should be withdrawn.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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